

wherein  $R_1$  is H, or a  $C_{1-30}$  straight or branched chain alkyl, aryl, or aralkyl; and  $R_2$  is COOM

wherein M is H;  $(CHR_1)_nOH$ ;  $(CH_2CH_2O)_nH$ ;  $(CH_2)_nNR_1$ ;  $(CHR_1CONR_1H)$  where n is 1-100,

and wherein the polar monomer is present at about 2 to 29% by weight of the total polymer; and

wherein said polymer is substantially free of monomers containing acetoacetoxy moieties; and

(b) applying to the nails a second composition comprising, by weight of the total composition:

1-99% solvent, and

1-99% of an film forming polymer, wherein the dried film formed by (a) and (b) resides on

the nails for five to ten days.

### REMARKS

Claims 1-19 and 21-27 are pending in the application. Claims 1-19 and 21-27 are rejected under 35 USC 102(b) as anticipated by Pagano. The Examiner contends that Applicants' prior arguments are not persuasive because patentability is based upon the use of two specific types of monomers and the subsequent polymerization to produce a polymer with non-yellowing ability as discussed in the Rule 132 Declaration; and that such non-yellowing property is not recited in the claims. The Examiner further states that Pagano's polymer contains at least the two monomers of the pending claims and that such claims do not exclude other monomers in the composition.

Applicants have amended the claims to clarify that the polymer used in the compositions, method, and kit does not contain any monomers that have acetoacetoxy moieties. Support for this change is found throughout the specification and examples of the pending application where it is clear that the polymers do not contain acetoacetoxy moieties as taught in Pagano's monomer B.

Pagano teaches a terpolymer, or a polymer that is obtained by polymerizing at least three monomers A, B, and C. While monomer A in Pagano is a nonpolar monomer, and monomer C is a polar monomer, the presence of monomer B is critical to the Pagano polymer composition. Monomer B is acetoacetoxyethylmethacrylate (see column 6, lines 25-27 of Pagano). In amended claim 1, the polymer is free of monomers that contain acetoacetoxy moieties.

Claim 17 is directed to a two component kit for painting the nails. The claim has been amended to specify that the film forming polymer in the nail enamel found in the first container is the composition defined in amended claim 1. While Pagano teaches two component kits, the kits taught must contain, in one container, the film forming terpolymer taught by Pagano. Amended claim 17 is directed to a kit having in the first container, a nail enamel composition containing a film forming polymer which is free of monomers containing acetoacetoxy moieties as defined in the claim. Since amended claim 17 teaches limitations not found in Pagano, that reference cannot by law anticipate. Claim 18 depends on claim 17 and if claim 17 is not anticipated by Pagano, claim 18 cannot be.

Claim 19, a method claim, has also been amended to clarify that the nail enamel composition in container one is as described in claim 1.

It is Applicants' position that the amended claims contain limitations not found in Pagano, thus this reference cannot anticipate. In particular, the polymer used in the claimed composition,

method, and kit is free of monomers that contain acetoacetoxy moieties. Further, in view of the prior Declaration submitted, the amended claims describe a composition that is not obvious over Pagano. More specifically, the composition of Pagano has a tendency to yellow the nails in certain individuals that choose to use formaldehyde based nail care products, not like the polymer used in the claimed composition. Further, In re Marosi, Stabenow, and Schwarzmann, 710 F.2d 799,803; 218 USPQ 289, 291-292 (Fed. Cir. 1983) stands for the proposition that a person of ordinary skill in the art would reasonably expect that if what was taught as an essential ingredient is not included an undesirable reaction or no reaction at all would occur. Accordingly, one skilled in the art would expect that if Pagano's B monomer is removed from the composition a most undesirable result would occur because Pagano teaches the criticality of a polymer containing this B monomer. However, removal of the B monomer from the polymer used in the claimed composition not only results in a composition that provides excellent wear and adhesion, but a composition that does not yellow the nails of individuals who choose to use formaldehyde based nail products. Under the rule of In re Marosi, the skilled artisan would expect quite the opposite.

The Examiner is respectfully requested to reconsider the rejection under 35 USC 102(b) and any rejection under 35 USC 103(a). The polymer used in the invention of the pending claims is free of any monomers containing acetoacetoxy moieties which distinguishes the claims from Pagano. Further, the fact that the polymer used in the claimed invention is missing a critical component of the Pagano polymer and yet still functions, and even exhibits improved properties over the Pagano polymer, is evidence of non-obviousness.

The Examiner is respectfully requested to reconsider the rejection of the claims under 35  
USC 102 and 103.

Respectfully Submitted,

  
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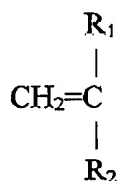
**MARKED UP COPY OF CLAIMS TO SHOW CHANGES MADE**

1. **(Twice Amended)** A nail enamel composition comprising, by weight of the total composition:

10-95% solvent, and

5-95% of a polymer having a glass transition temperature in the range of 5 to 90°

C., obtained by polymerizing at least two different types of monomers wherein one monomer is a nonpolar ethylenically unsaturated monomer and the other monomer is a polar monomer of the formula:



wherein  $R_1$  is H, or a  $C_{1-30}$  straight or branched chain alkyl, aryl, or aralkyl; and  $R_2$  is COOM

wherein M is H;  $(CHR_1)_nOH$ ;  $(CH_2CH_2O)_nH$ ;  $(CH_2)_nNR_1$ ;  $(CHR_1CONR_1H)$  where n is 1-100, and

wherein the polar monomer is present at about 2 to 29% by weight of the total polymer; wherein said polymer is substantially free of monomers containing acetoacetoxy moieties.

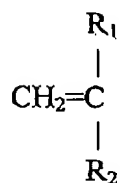
17. **(Twice Amended)** A two container kit for polishing nails comprising:

(a) a first container containing a nail enamel composition comprising, by weight of the total composition:

10-95% solvent, and

5-95% of a film forming polymer having a glass transition temperature in the range of 5 to 90° C. obtained by polymerizing at least two different types of monomers wherein one monomer is

a nonpolar ethylenically unsaturated monomer and the other monomer is a polar monomer of the formula:



wherein  $R_1$  is H, or a  $C_{1-30}$  straight or branched chain alkyl, aryl, or aralkyl; and  $R_2$  is COOM wherein M is H;  $(CHR_1)_nOH$ ;  $(CH_2CH_2O)_nH$ ;  $(CH_2)_nNR_1$ ;  $(CHR_1CONR_1H)$  where n is 1-100, and wherein the polar monomer is present at about 2 to 29% by weight of the total polymer; wherein said polymer is substantially free of monomers containing acetoacetoxy moieties; and

(b) a second container containing a nail enamel topcoat composition comprising, by weight of the total topcoat composition:

1-99% solvent, and

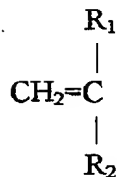
1-99% of a film forming polymer.

**19. (Twice Amended)** A method for polishing the nails comprising:

(a) applying to the nails a first composition comprising, by weight of the total composition:

10-95% solvent, and

5-95% of a film forming polymer having a glass transition temperature in the range of 5 to 90° C. obtained by polymerizing at least two different types of monomers wherein one monomer is a nonpolar ethylenically unsaturated monomer and the other monomer is a polar monomer of the formula:



wherein  $R_1$  is H, or a  $C_{1-30}$  straight or branched chain alkyl, aryl, or aralkyl; and  $R_2$  is COOM

wherein M is H;  $(CHR_1)_nOH$ ;  $(CH_2CH_2O)_nH$ ;  $(CH_2)_nNR_1$ ;  $(CHR_1CONR_1H)$  where n is 1-100,

and wherein the polar monomer is present at about 2 to 29% by weight of the total polymer; and

wherein said polymer is substantially free of monomers containing acetoacetoxy moieties; and

(b) applying to the nails a second composition comprising, by weight of the total composition:

1-99% solvent, and

1-99% of an film forming polymer; wherein the dried film formed by (a) and (b) resides on the nails for five to ten days.